



**STATEMENT OF ARGUMENTS IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Claims 16-21, 23 and 28 were rejected under 35 U.S.C. §102(e) over Soeholm et al, (U.S. Patent Publication No. 2004/0185770). In addition, claim 22 was rejected under 35 U.S.C. §103(a) over Soeholm et al. in view of Potter (U.S. Patent No. 4,552,059), and claims 24-27 and 29-31 were rejected under 35 U.S.C. §103(a) over Soeholm et al. in view of “being a design choice”. The Final Rejection includes the errors that follow:

**Error #1 The Examiner has not pointed out where Soeholm et al.’s provisional application (No. 60/453,086) supports the subject matter of the pending claims.**

Each of the rejections in the Final Rejection relies on the teachings of Soeholm et al., which was filed on November 13, 2003. In order to overcome that rejection, Applicant submitted a certified English translation of Applicant’s German priority application No. 103 16 571.1, filed April 10, 2003, which is before the November 13, 2003 filing date of Soeholm et al.

Accordingly, Applicant respectfully submits that Soeholm et al. does not qualify as prior art as to the present application.

As pointed out in the Remarks section of the Amendment filed on October 7, 2010, to the extent that the Examiner relies on Provisional Application No. 60/453,086, which was filed on March 6, 2003, i.e., about a month before the filing date of the above mentioned German priority document, the provisional application does not appear to include the disclosure in U.S. Patent Publication No. 2004/0185770 which the Examiner relied upon in order to reject the claims of the present application.

The Examiner responds to this argument on the paragraph bridging pages 6 and 7 of the Final Rejection, under the “Response to Arguments” section of the Final Rejection.

In particular, instead of pointing out those portions of Provisional Application No. 60/453,086 which allegedly disclosed the claimed features, the Examiner simply takes the position that “The exact disclosure in the application 2004/0185770 is not required in the provisional application. Applicant has not pointed to any particular limitation not supported by the provisional application and going through the limitations used in the rejection above the Examiner does not see any limitations not supported”.

The Examiner’s reasoning is flawed. While it is not necessary that the provisional application include the exact disclosure of the published application, the provisional application must support the rejection in terms of 35 U.S.C. §112, first paragraph. Moreover, the Examiner’s quote that the “exact disclosure is not required as between the provisional and

the non-provisional” is misleading. In fact, the provisional application does not remotely resemble what was filed in the non-provisional application. In particular, the provisional application appears to be a product information brochure, not a patent application written to conform with the requirements of 35 U.S.C. §112, first paragraph. For example, the “EXHAUSTO” product information guide does not include Figures 1, 2, 4, 5, 6, 7 or 8 from the non-provisional application. Rather, the provisional application only appears to include Figures 3A and 3B of the non-provisional application (see page 2 of the “EXHAUSTO” product information guide).

In any event, now that the published application has been disqualified as prior art since its filing date is after the filing date of Applicant’s German priority application, it is incumbent on the Patent Office to specifically point out where the “EXHAUSTO” product information document discloses the subject matter of the claimed invention. The Examiner must point out where the provisional application discloses each and every one of the features of claims 16-31. See 37 CFR 1.104(c)(2).

In the Office Action, the Examiner instead points to the disclosure of the published non-provisional application, which as mentioned above has very little correlation to the EXHAUSTO product information document. In particular, the Examiner points to Figure 1 as supporting her rejection, as well as several paragraphs ([0034], [0035], [0036], [0038], [0058], etc.). However, Figure 1 is not in the provisional application, and nor does it appear that the cited paragraphs are included.

In addition, the Examiner seems to take the position that since Soeholm et al.’s U.S. Patent No. 7,275,533 was granted a priority date as of the filing date of the provisional application, the non-provisional application of Soeholm et al. must be supported by the provisional application. Applicant respectfully submits that the claim for priority is granted simply by fulfilling the requirements of 35 U.S.C. §119(c). However, just because the claim for priority is not granted, does not mean that the subject matter of the non-provisional application is supported by the provisional application.

Reconsideration and withdrawal of the rejection are respectfully requested.

**Error #2 Soeholm et al. does not teach or disclose a cooking device (claim 16).**

Claim 16 is directed to a control device that includes a cooking device, a room with a fan arranged in the room and a pressure difference detection device as well as a control device.

In the Office Action, the Examiner takes the position that Soeholm et al. teaches a cooking device. In support of this portion of the rejection, the Examiner points to paragraph

[0026] and the Examiner specifically indicates that this paragraph discloses a heating device. However, a cooking device is a specific type of heating device, and such that the disclosure of a heating device in paragraph [0026] is not a disclosure of the cooking device.

In addition, as indicated above, the Examiner has only pointed to the disclosure of the non-provisional application, whereas to support the rejection in this particular case, the Examiner is obligated to point to the disclosure of the provisional application in order to establish a *prima facie* case for rejecting the claim. In this particular case, because the disclosures of the provisional and non-provisional applications are so different, it is incumbent on the Examiner to point to that portion or those portions of the provisional application that support the rejection. This must be done for each independent claim as well as each dependent claim.

More specifically, on page 1 of the “EXHAUSTO” product information document, there is an indication that typical uses include controlling draft in a mechanical draft system serving boilers and water heaters, controlling position of an over draft damper serving boilers and water heaters, controlling duct pressure in a dryer venting system or a ventilation system, or controlling a line of combustion into a mechanical room. There is no disclosure of a cooking device in this section of the provisional application.

Reconsideration and withdrawal of the rejection are respectfully requested.

**Error #3 The Examiner’s reliance on “obvious design choice” is improper.**

In the Final Rejection, page 4, the Examiner takes the position that claims 24-27 and 29-31 are unpatentable over Soeholm et al. in view of being a design choice. In the context of that rejection, the Examiner admits that Soeholm et al. does not teach a predetermined pressure difference threshold of 4 Pascal. To make up for the deficiency, the Examiner takes the position that the recited different threshold of 4 Pascal is an obvious matter of design choice since Applicant has failed to establish any criticality or synergistic results which are derived from the recited configurations.

However, Applicant specifically pointed out that the advantage to this arrangement is provided on page 7, lines 14-23 of the original specification. In the Response to Arguments section of the Final Rejection, the Examiner indicates that the claim does not require an open fireplace with a chimney in a room. However, it is not necessary to recite these elements as Applicant simply has pointed out an advantage to the claimed arrangement.

Reconsideration and withdrawal of the rejection are respectfully requested.

For the reasons noted above, the Final Rejection should be withdrawn and the application passed to allowance.